REMARKS

Introduction

Claims 1 to 33 are currently pending. Claims 1, 12, 23, and 31-33 have been amended. Reconsideration of the rejection of the application is respectfully requested in view of the above amendments and the following remarks.

Rejection of Claims 1, 12, 23, and 31-33

Claims 1, 12, 23, and 31-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Oberlander et al., U.S. Pat. No. 5,825,865 ("Oberlander") in view of Gordon, U.S. Pat. No. 5,608,786 ("Gordon"), and further in view of U.S. Patent No. 5,708,655 to Toth et al.("Toth"). It is submitted that all of claims 1, 12, 23, and 31-33 are allowable over the applied references for the following reasons.

Each of independent claims 1, 12, 23 and 31 recite analogous subject matter, and therefore, the following discussion with respect to claim 12 applies equally to each of claims 1, 12, 23 and 31.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As amended, independent claim 12 provides, *inter alia*, a computer program product for execution in connection with a telephony process executed on a terminal device processing unit, the computer program product having program code comprising: A) program code for receiving, at the terminal device processing unit, an incoming communication over the computer network containing a call packet having an information profile identifying one of the plurality of

telephony processes which is the source of the incoming communication; and B) program code executable at the terminal device processing unit, responsive to the information profile, for selectively notifying a user of the incoming communication by transmitting a responsive packet over the computer network in accordance with the identity of the source.

The Office Action relies on the Oberlander reference as disclosing the feature of selectively alerting a user of an incoming communication by receiving an incoming communication containing an information profile and responding to the incoming communication in accordance with the identity of the source. However, the Oberlander reference concerns a network-driven call redirection system where all of the aforementioned steps occur at network switches, rather than in connection with a telephony processes executed on a terminal device processing unit as indicated clearly within the Applicants' specification.[1] For example, the cited section of Oberlander provides that "upon receiving indicia of a need to transmit a message . . . the network obtains the recipient address from the message." Oberlander, col. 8, lines 17-22 (emphasis added). It is then stated that "using this information, the network then interfaces with the controller to access the information profile for the designated recipient. Based upon the . . . information profile for the recipient, a particular destination is then selected." Oberlander, col. 8, lines 24-29 (emphasis added). As can be discerned, the code for reception of the incoming communication, and the code for responding selectively based on the identity of the source, resides at the network switches, and the associated execution of that code also occurs at the network switches. In sharp contrast, claim 12 calls for this code to be executed in connection with a telephony process executed on a terminal device processing unit.

The difference highlighted here is significant because the present invention, unlike Oberlander, allows an end user to control the flexible responses at his or her own computer system using information profiles stored on a local database or directory. Interaction with an external network switch or a database residing on the network is not required in order to achieve differential responses based on the identity of the caller.

It is accordingly submitted that Oberlander does not disclose these significant aspects of the claimed invention. In addition, neither Gordon nor Toth discloses or suggests the subject matter of claim 12. The Gordon reference refers to a system for providing communication

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[1] E.g., on page 8 of the specification it is stated that the processing units which send and receive signals, i.e., terminal communication devices, execute an IP telephony application (telephony process).

services via commercial-access-providing computers coupled to the Internet. It does not mention or refer to a telephony process executed on a terminal device, let alone the specific functionality of selectively responding to incoming communication based upon the identity of the source. The Toth reference relates to a method of communicating packet data to a wireless communication device using a temporarily-assigned address. Toth also fails to mention or refer to executing a telephony process at a terminal device processing unit that includes code for selectively responding to incoming communication based upon the identity of the source.

For at least these reasons, it is submitted that the applied references do not disclose or suggest the recited features of claim 12, which is therefore patentable over the applied references.

As claims 1, 23, and 31 recite features analogous to those recited in claim 12, it is submitted that claims 1, 23, and 31 are likewise patentable over the applied references.

Claims 32 and 33 recite the feature that the information profile sent to the called telephone process enables the called telephone process to extract selective response information based on the information profile from a local database. As discussed above, none of the applied references, taken individually or in combination, suggest a called telephone process extracting selective response information based on the information profile from a local database, since the applied references refer only to extraction of information within the network, rather than from local databases (such as a directory stored on a terminal device). Therefore, it is submitted that claims 32 and 33 are also patentable over the applied references.

Withdrawal of the rejection of claims 1, 12, 23, and 31-33 under 35 U.S.C. § 103(a) is accordingly respectfully requested.

Rejection of Claims 2-11, 13-22, and 24-30

Claims 2-11, 13-22 and 24-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Oberlander in view of Gordon and Toth, and further in view of U.S. Patent No. 5,708,422 to Blonder et al. ("Blonder"). It is submitted that all of claims 2-11, 13-22 and 24-30 are allowable over the applied references for the following reasons.

Claims 2-11, 13-22 and 24-30 depend from, and incorporate the features of, independent claims 1, 12 and 23, respectively.

The Blonder reference relates to a transaction authorization system and does not concern or mention a telephony process running on a computer system. Like the Oberlander reference, Blonder refers to a centralized database matching process that is performed in the network, rather

than in connection with a telephony process executed on a terminal device processing unit. Accordingly, both the matching process for determining whether a transaction should or should not be authorized, and the generation of alert signals according to Blonder occur at the network rather than in connection with the telephony process executed on a terminal device processing unit. Thus, Blonder does not disclose a program code for receiving, at a terminal device processing unit, an incoming communication over the computer network containing a call packet having an information profile identifying one of the plurality of telephony processes which is the source of the incoming communication, or disclose a program code executable on the terminal device processing unit, responsive to the information profile, for selectively notifying a user of the incoming communication by transmitting a responsive packet over the computer network in accordance with the identity of the source. Therefore, Blonder fails to cure the deficiencies of the Oberlander, Gordon and Toth references discussed above with respect to claims 1, 12, and 23. Since each of the features of the independent claims 1, 12 and 23 are not disclosed or suggested by the applied references, dependent claims 2-10, 13-22 and 24-30 are patentable over the applied references.

Withdrawal of the rejection of claims 2-10, 13-22 and 24-30 under 35 U.S.C. § 103(a) is therefore respectfully requested.

Conclusion

All issues having been addressed, it is believed that the present application is in condition for allowance. Prompt reconsideration and allowance of the present application are respectfully requested.

Respectfully submitted,

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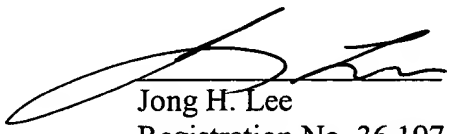

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